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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,962

12/08/2006

Dudley Finch

122438.124348.0001

1378

24335 7590 10/07/2008  
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EXAMINER

COHEN, LEE S

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

10/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,962	<b>Applicant(s)</b> FINCH ET AL.	
	<b>Examiner</b> Lee S. Cohen	<b>Art Unit</b> 3739	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 9-13, 23 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-22, 24, 25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 9-13, 23, and 26 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 9, 2008.

The traversal is not found persuasive because, as claimed (claim 1), fails to require a shape memory polymer for patentability. Further, the search for a coating per se would require additional searching outside of the electrode areas.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 14-22, and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 lacks clarity in that the phrase "slowly implantable" lacks specificity. What such language actually defines is unclear. Claim 15 - "the coating" lacks antecedent basis. Claim 16 is vague as the limitation could define multiple meanings (i.e., slow implantation by the practitioner, slow implantation be the electrode per se, etc.). Claim 17 is vague as to how surface engineering the electrode relates to a method of inserting. Claim 18 lacks clarity as how the inserting steps defines a method as set forth in the preamble of the claim. Claim 19 – "the coating" lacks antecedent basis. Claim 20 is vague as the limitation could define

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multiple meanings (i.e., slow implantation by the practitioner, slow implantation by the electrode per se, etc.). Claims 21 and 22 are rejected as claim 1. Claim 27-29 lack any actual method steps which result in the formation of an electrode.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Balat et al (4,258,724). Applicant's attention is directed to column 4, lines 26-50.

Claims 1, 7, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mayer et al (4,827,940). Applicant's attention is directed to column 4, lines 45+.

Claims 1, 3, 4, 7, 8, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Parker et al (5,653,742). Applicant's attention is directed to column 3, lines 30-48.

Claims 1, 3, 4, 7, 8, 14-20, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Madsen (6,091,979). Applicant's attention is directed to column 4, lines 34-50.

Claims 1, 2, 8, 14, 16-18, 20, 21, and 27-29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mojarradi et al (2004/0006264). Applicant's attention is directed to paragraph [0019]. The electrode is implanted slowly into the brain.

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Claims 1, 2, 8, 14, 16-18, 20, 21, and 27-29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by He et al (2005/0021117). Applicant's attention is directed to paragraph [0026]. The electrode is implanted slowly into the brain.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parker at al (5,653,742)/ Madsen (6,091,979) in view of Fischell et al (6,427,086). The primary references lack the inclusion of therapeutic material in the coating. The addition of such material to resorbable coatings is well known as shown by Fischell et al at column 35, lines 25-37. Given such a teaching, it would have been obvious to the skilled artisan to add such material to the coatings of the primary references. Selection of particular materials, as claimed, which are well known would have been further obvious to achieve desired effects since a predictable result would ensue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee S. Cohen whose telephone number is 571-272-4763. The examiner can normally be reached on Monday-Friday, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lee S. Cohen  
Primary Examiner  
Art Unit 3739

/Lee S. Cohen/  
Primary Examiner, Art Unit 3739  
September 4, 2008